

Notice of Allowability

Application No.

10/764,922

Examiner

Evelyn Huang

Applicant(s)

BANHOLZER ET AL.

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to amendment filed on 9-27-2004.
2. ☒ The allowed claim(s) is/are 11-14.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 10/448,493.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

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Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 7-10, drawn to an intermediate bicyclic compound of formula II, classified in class 546, subclass 131.
 - II. Claims 11-14, drawn to an intermediate tricyclic compound of formula IV, classified in class 546, subclass 90.

The inventions are distinct, each from the other because of the following reasons:

The Group I bicyclic compound and the Group II tricyclic compound have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. A reference anticipating the Group I invention would not render obvious the Group II invention. Since the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

2. During a telephone conversation with Ms. Small on 9-22-2004, a provisional election was made without traverse to prosecute the invention of Group II, claims 11-14. Claims 7-10 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

EXAMINER'S AMENDMENT

3. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

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Authorization for this examiner's amendment was given in a telephone interview with Ms. Small on 12-15-2004. During the interview, the examiner suggested deleting the non-elected claims 7-10 to place the application in conditions for allowance.

The application has been amended as follows:

Delete claims 7-10.

REASONS FOR ALLOWANCE

4. The following is an examiner's statement of reasons for allowance:

Claims 11-14 are allowed.

The rejection for 11-13 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is withdrawn in view of the amendment amending R1 to R, and amending R2 to methyl as described in the specification.

The rejection for Claims 11-14 are under 35 U.S.C. 112, second paragraph, is withdrawn because the amendment has obviated the rejection.

The rejection for Claims 7-10 under 35 U.S.C. 102(b) as being anticipated by Sheehan et al (J. Org. Chem. 1954, 19:270-6) is rendered moot by the cancellation of these claims.

The rejection for Claims 7-8 under 35 U.S.C. 102(b) as being anticipated by Achari et al (Planta Medica. 1972, 22(1):38-41) is rendered moot by the cancellation of these claims.

The rejection for Claim 7 under 35 U.S.C. 102(b) as being anticipated by Al-Said et al. (Pytochemistry. 1989, 28(2):671-3) is rendered moot by the cancellation of this claim.

The timely filed terminal disclaimer has obviated the rejection for claims 11-14 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6747153.

The compound of Buchi (J. Org. Chem. 1977, 42(12):2193-2194, page 2193, compound 8) has a methoxy and an oxo instead of the instant NR"R" and OCOR1 respectively. Motivation to modify Buchi's compound to arrive at the instant invention is lacking.

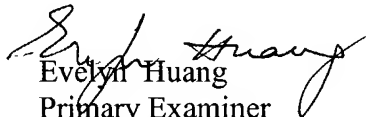
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5. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evelyn Huang whose telephone number is 571-272-0686. The examiner can normally be reached on Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Evelyn Huang
Primary Examiner
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